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Paper 36

Filed: December 14, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Jameson Lee)

HAROLD R. GARNER
Junior Party
(Application 09/998,341),

v.

CALVIN F. QUATE
and
DAVID STERN
Senior Party
(Patent 6,480,324).
Patent Interference No. 105,455 (JL)
(Technology Center 1600)

Before SCHAFER, LEE, and MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

Decision on Order to Show Cause - Bd. R. 202(d)

A. Introduction

1. Presently before the Board is a response (Paper 15) by Garner to an order to show cause (Paper 3).

1 2. The order to show cause ordered Garner to explain why judgment should not
2 be entered against it based upon its failure to establish that it could prevail on the issue
3 of priority. 37 CFR § 41.202(d) (2005).

4 3. For the reasons which follow, we hold that Garner has not shown good cause
5 for admitting the evidence provided in its response to the order to show cause and
6 decline to admit it.

7 4. For the reasons which follow, we hold that Garner has not adequately
8 explained why judgment should not be entered against it based on its Bd. R. 202(d)
9 submissions to the examiner.

10 5. Accordingly, at this time it is appropriate to enter judgment against Garner.

11 B. Findings of Fact

12 1. This interference was declared September 6, 2006. (Paper 1).

13 2. Junior Party Garner, the applicant, provoked the interference. (Paper initially
14 submitted October 24, 2005 in Application 09/998,341).

15 3. The October 24, 2005 submission in Application 09/998,341 contained two
16 declarations, one by John Fondon dated October 20, 2005 (hereinafter Fondon I) and
17 one by Harold Garner dated November 28, 2001 (hereinafter Garner I).

18 4. Interferences are discretionary with the Director of the United States Patent
19 and Trademark Office. See, e.g. 35 U.S.C. §135(a) ("Whenever an application is made
20 for a patent which, in the opinion of the Director, would interfere with any pending
21 application, or with any unexpired patent, an interference **may** be declared. . .")
22 (emphasis added).

1 5. The Director has set forth rules for the conduct of interferences. See, e.g. 37
2 CFR § 41 (2004).

3 6. To avoid potential harassment of patentees by applicants, one of the rules
4 imposed by the Director is 37 CFR § 41.202 (2004) which governs suggesting
5 interferences.

6 7. 37 CFR § 41.202 provides in pertinent part as follows:

7 § 41.202 Suggesting an interference.

8
9 (a) Applicant. An applicant, including a reissue applicant, may suggest an
10 interference with another application or a patent. The suggestion must:

11 ...
12 (4) Explain in detail why the applicant will prevail on priority,

13
14 ...

15
16 (d) Requirement to show priority under 35 U.S.C. 102(g)

17
18 (1) When an applicant has an earliest constructive reduction to practice
19 that is later than the apparent earliest constructive reduction to practice for
20 a patent or published application claiming interfering subject matter, the
21 applicant must show why it would prevail on priority.

22
23 (2) If an applicant fails to show priority under paragraph (d)(1) of this
24 section, an administrative patent judge may nevertheless declare an
25 interference to place the applicant under an order to show cause why
26 judgment should not be entered against the applicant on priority. New
27 evidence in support of priority will not be admitted except on a showing of
28 good cause. The Board may authorize the filing of motions to redefine the
29 interfering subject matter or to change the benefit accorded to the parties.

30
31 (e) Sufficiency of showing.

32
33 (1) A showing of priority under this section is not sufficient unless it would,
34 if un rebutted, support a determination of priority in favor of the party
35 making the showing.

36 ...

1 8. The examiner in Application 09/998,341 advised Garner that the 37 CFR
2 § 1.131 submission was insufficient for a 37 CFR § 41.202. (Office Action, December
3 27, 2005).

4 9. A second opportunity to comply with Bd. R. 202(d) was permitted by the
5 Examiner in Application 09/998,341 (Office Action December 27, 2005).

6 10. A second request was filed on January 26, 2006 in Application 09/998,341,
7 including a "Declaration Under 37 C.F.R. § 41.202(d)" signed December 8, 2005 by
8 inventor Garner with attachments (hereinafter Garner II) and a second copy of the
9 Fondon I declaration (Fondon II) and attachments.

10 11. The second request was substantively the same as the first request.

11 12. Simultaneous with the Declaration of this interference on September 6,
12 2006, the Board placed the Applicant under an order to show cause (Paper 3).

13 13. The Board in paper 3 again determined that the totality of the showing
14 provided by Garner under 37 CFR § 41.202(d) from these three sources was
15 insufficient, if unrebutted, to support a determination of priority in favor of Garner.

16 14. Accordingly, Garner was ordered to show cause why judgment should not be
17 entered against it. (Paper 3).

18 15. Garner has responded with Paper 15 on September 26, 2006.

19 16. Garner does not challenge the findings of the show cause order of Paper 3.

20 17. Instead, Garner responds to the show cause order by going through the
21 prosecution history of application 09/998,341 for additional evidence in support of its
22 originally filed 202(d) showing.

1 18. Paper 15 asserts that it relies on no new evidence, but “evidence of record”
2 (Paper 15, page 1, line 5).

3 19. As Garner has misconstrued rule 202(d), It is evident that an amplified
4 discussion of rule 202(d) is warranted here.

5 C. Discussion

6 i) The History and Function of a 202(d)(1) Showing

7 Interferences are lengthy, complicated, and expensive proceedings. A form of
8 summary judgment, such as that provided by Rule 202(d)(2) is one way to reduce the
9 costs associated with interferences.

10 Initially, the PTO implemented summary judgment proceedings in interferences
11 in 1965 by amending 37 CFR §1.204(b), and adding 37 CFR §1.204(c) and 1.228. (29
12 Fed. Reg. 15866 (Nov. 26, 1964)).

13 Former rule 204(c) provided that:

14 When the effective filing date of an applicant is more than 3 months
15 subsequent to the effective filing date of the patentee, the applicant,
16 before the interference will be declared, shall file two copies of affidavits or
17 declarations by himself, if possible, and by one or more corroborating
18 witnesses, supported by documentary evidence if available, each setting
19 out a factual description of acts and circumstances performed or observed
20 by the affiant, which collectively would entitle him to an award of priority
21 with respect to the effective filing date of the patent. This showing must
22 be accompanied by an explanation of the basis on which he believes that
23 the facts set forth would overcome the effective filing date of the patent.
24 Failure to satisfy the provisions of this section may result in summary
25 judgment against the applicant under §1.228. (37 CFR §1.204(c)(1965))
26

27 In short, if a junior party applicant didn't have the proof up front, that
28 applicant lost.
29
30

1 As noted in Kistler v. Weber, 412 F.2d 280, 285, 162 USPQ 214, 218-219 (CCPA
2 1969) " [t]he expense involved in a protracted interference, and the special hardships
3 workable on a patentee involved therein, are notorious, and to minimize both, where
4 possible, would appear to be the laudable purpose of these rules. If a junior party
5 [applicant] is in fact 'a first inventor' and if he could prove that in a 'full hearing on
6 priority,' we see no reason why he should be prejudiced or unduly burdened by a
7 requirement that he prove (prior to a 'full hearing') by way of affidavits and documentary
8 evidence that he is at least prima facie entitled to an award of priority over the
9 patentee's effective filing date."

10 However, those rules were not without administrative difficulties for the agency
11 resulting from defective initial showings. When rule 204(c) and 228 were replaced with
12 rules 617 and 608 in 1984, the PTO observed during the rule making process that:

13 Section 1.617 retains summary judgment proceedings in those cases
14 where a junior party applicant is required to file evidence and an
15 explanation under § 1.608(b). To avoid summary judgment, the junior
16 party applicant must establish that it is prima facie entitled to judgment
17 relative to the senior party patentee. For the most part, practice under §
18 1.617 will be the same as the current practice under 37 CFR 1.228. The
19 major changes would be the following: (1) A prima facie case could be
20 based on patentability as well as priority. (2) A stricter standard would be
21 imposed for presenting additional evidence after entry of an order to show
22 cause. Under current practice (37 CFR 1.228), additional evidence may be
23 submitted with a response to an order to show cause "when a showing in
24 excuse of . . . [its] omission from the original" showing is made. **The**
25 **"good cause" showing required by § 1.617(b) imposes a stricter**
26 **standard than was required under the prior rules. The stricter**
27 **standard is necessary to encourage applicants copying claims from**
28 **a patent to better prepare their initial showings under proposed §**
29 **1.608(b). Under current practice, the Board of Patent Interferences**
30 **has found that substantial time is lost in issuing orders to show**
31 **cause based on an inadequate initial showing only to have an**

1 adequate showing made with the response to the order to show
2 cause. Under the "good cause" standard, ignorance by a party or
3 counsel of the provisions of the rules or the substantive
4 requirements of the law would not constitute good cause. (49 FR
5 3775, col. 1)(Emphasis Added).
6

7 In other words, in the period leading up to 1984, the Board was facing a problem
8 of inadequate initial showings which wasted time and Board resources in having to
9 review a second submission when there was no reason the arguments and evidence
10 had not been provided earlier.

11 Rule 617 was explained by the Federal Circuit as implemented to practice
12 Hahn v. Wong, 892 F.2d 1028, 13 USPQ2d 1313 (Fed. Cir. 1989) "tighten" up on initial
13 showings because the "public interest requires the prompt resolution of interferences
14 and not piecemeal prosecution." See Hahn v. Wong, 13 U.S.P.Q.2d 1211, 1214 (Bd.
15 Pat. App. & Interf. 1989). There are several reasons why this step was taken by the
16 Director - to manage a process more efficiently, limit patentee exposure to harassment,
17 and reduce overall pendency of interferences and applications involved in interferences
18 with concomitant patent term extension.

19 As noted in HR 6286, the Patent Law Amendments Act of 1984:

20 The longest interference took over 13 years in the Patent and Trademark
21 Office. While most interferences are not that long, the substantial delays in
22 issuing a patent due to the lengthy interference proceedings and
23 subsequent ex partes proceedings are harmful to both applicants and the
24 public. Lack of confidence in the patent law system is the ultimate result.
25 In response to the problem, the Patent and Trademark Office already has
26 published regulations to streamline this process (49 Fed. Reg. 3788 (Jan.
27 30, 1984)). (Congressional Record, October 1, 1984, H10525-29).
28

1 It was the intent of the Director to limit the problem of multiple attempts to make
2 out a prima facie case that the applicant would prevail on priority with the promulgation
3 of former rules 617 and 608(b).

4 Former rules 608(b) and 617 provide as follows, in pertinent part:

5 §1.608 (b) When the earlier of the filing date or the effective filing date of
6 an application is more than three months after the earlier of the filing date
7 or the effective filing date under 35 U.S.C. 120 of a patent, the applicant,
8 before an interference will be declared, shall file (1) evidence which may
9 consist of patents or printed publications, other documents, and one or
10 more affidavits which demonstrate that applicant is prima facie entitled to
11 a judgment relative to the patentee and (2) an explanation stating with
12 particularity the basis upon which the applicant is prima facie entitled to
13 the judgment. Where the basis upon which an applicant is entitled to
14 judgment relative to a patentee is priority of invention, the evidence shall
15 include affidavits by the applicant, if possible, and one or more
16 corroborating witnesses, supported by documentary evidence, if available,
17 each setting out a factual description of acts and circumstances performed
18 or observed by the affiant, which collectively would prima facie entitle the
19 applicant to judgment on priority with respect to the earlier of the filing date
20 or effective filing date of the patent. . . (37 CFR §1.608(b)(1984))

21
22 § 1.617 Summary judgment against applicant.

23
24 (a) An examiner-in-chief shall review any evidence filed by an applicant
25 under § 1.608(b) to determine if the applicant is prima facie entitled to a
26 judgment relative to the patentee. If the examiner-in-chief determines that
27 the evidence shows the applicant is prima facie entitled to a judgment
28 relative to the patentee, the interference shall proceed in the normal
29 manner under the regulations of this part. If in the opinion of the examiner-
30 in-chief the evidence fails to show that the applicant is prima facie entitled
31 to a judgment relative to the patentee, the examiner-in-chief shall,
32 concurrently with the notice declaring the interference, enter an order
33 stating the reasons for the opinion and directing the applicant, within a
34 time set in the order, to show cause why summary judgment should not be
35 entered against the applicant.

36
37 (b) The applicant may file a response to the order and state any reasons
38 why summary judgment should not be entered.
39

1 This higher standard requiring "good cause" is discussed in Basmadjian v.
2 Landry 54 USPQ2d 1617, 1621 (Bd. Pat. App. & Interf. 1997)(Precedential):

3 [a]dditional evidence shall not be presented by the applicant or considered
4 by the Board unless the applicant shows good cause why any additional
5 evidence was not initially presented with the evidence filed under §
6 1.608(b). Id. [37 CFR §1.617(b)] The "good cause" standard was first
7 promulgated in the 1984 amendments to the interference rules. Notice of
8 Final Rule, supra. [49 Fed. Reg. 84816, 48421 col. 3 (Dec. 12, 1984)]. In
9 addition to the Notice of Final Rule, a discussion of the "good cause"
10 standard can be found in Hahn v. Wong, 892 F.2d 1028, 13 USPQ2d
11 1313 (Fed. Cir. 1989). Before 1984, supplemental evidence would be
12 accepted upon a "showing in excuse of *** [the] omission [of the
13 supplemental evidence] from the original showing." 37 CFR § 1.288
14 (1984). The language of Rule 288 set "no standard for showing in
15 excuse." Nakayama v. Banner, 588 F.2d 1336, 1342-43, 200 USPQ 266,
16 270 (CCPA 1978). Under the "good cause" standard of 37 CFR §
17 1.617(b), ignorance by a party or counsel of the provisions of the rules or
18 the substantive requirements of the law would not constitute good cause.
19 Notice of Final Rule, supra at 48423, 1050 Off. Gaz. Pat. Office at 392. On
20 the other hand, "good cause" might be shown if evidence first comes into
21 existence after a Rule 608(b) showing is filed. Huston v. Ladner, 973 F.2d
22 1564, 1566, 23 USPQ2d 1910, 1912-13 (Fed. Cir. 1992) ("if the evidence
23 was not available when the original showing was filed, this would have
24 been a valid excuse for not filing the evidence"). Another basis upon which
25 "good cause" might be established would be where a diligent effort to find
26 evidence was unsuccessful prior to filing the Rule 608(b) showing, but
27 continued diligence ultimately succeeded in locating the evidence after the
28 showing was filed. Whether an applicant has shown "good cause" is a
29 matter within the discretion of the board. Hahn v. Wong, supra at 1034, 13
30 USPQ at 1318.

31
32 Current Rule 202(d) carries forward to the present day the intent of former rules
33 617 and 608(b) in ensuring the showing is complete at the start, with all necessary
34 evidence submitted with the showing.

35 In the notice of rulemaking, the PTO stated:

36 Proposed § 41.202(d) would set forth the basis for a summary proceeding
37 when an applicant does not appear to be able to show it would prevail on

1 priority. Proposed § 41.202(d)(1) would restate Rule 608, but would
2 eliminate the distinction between Rule 608(a) and Rule 608(b). The
3 requirement could be made under 35 U.S.C. 132 even when a rejection is
4 not available. Failure to comply with the requirement would result in
5 abandonment of the application under 35 U.S.C. 133. Proposed
6 § 41.202(d)(2) would restate Rule 617 by providing a basis for a summary
7 proceeding on priority when the applicant fails to make a sufficient
8 showing of priority. To be sufficient, under proposed § 41.202(e), the
9 showing would by itself, if unrebutted, have to warrant a determination of
10 priority. (68 FR 66664, col. 3)(Nov. 26, 2003)(emphasis added).

11
12 Accordingly, Rule 202(d) now focuses on the showing, by itself, and the evidence
13 contained therein, as the record for consideration in any show cause order. Anything
14 else is “new” evidence, even if it is contained elsewhere in the PTO.

15 ii) Portions of Garner’s Evidence Now Relied Upon are
16 The Evidence

17 Bd. R. 202(d)(2) permits an administrative patent judge to declare an interference
18 to place an applicant under an order to show cause. Bd. R. 202(d)(2) expressly
19 provides that “[n]ew evidence in support of priority will not be admitted except on a
20 showing of good cause.”

21 Garner states that “. . . Garner relies on the following pieces of evidence of
22 record.” (Paper 15, page 1, lines 6-7). Garner then lists 5 pieces of “evidence.”

23 We address each piece of “evidence.”

24 1. The specification of Garner provisional application number 60/087,948.

25 This specification is not part of Garner’s 202(d)(1) showing submitted January
26 26, 2006 or its predecessor of October 24, 2005. At best, Garner mentioned the
27 provisional application in passing by noting that priority is claimed to the provisional

1 application. No argument pointing specifically to any specific evidence provided at the
2 time of the 202(d) statement was made in the 202(d)(1) statement. Accordingly, this is
3 precisely the type of "new evidence" rule 202(d) is designed to prevent from being
4 admitted without good cause.

5 2. The specification of the Garner application involved in this interference, Serial
6 Number 09/998,341.

7 Again, this specification is not part of Garner's 202(d)(1) showing submitted
8 January 26, 2006 or its predecessor of October 24, 2005. Furthermore, Garner did not
9 make any mention of any particular portion of the specification or any reason why that
10 specification should be utilized in the 202(d)(1) statement to support its showing. Again,
11 this is precisely the type of "new evidence" rule 202(d) is designed to prevent from being
12 admitted without good cause.

13 3. A document entitled "Declaration Under 37 C.F.R. §1.131 of Prior Invention in
14 the United States to Overcome Cited References" signed by inventor Harold R. Garner
15 on August 22, 2003 and submitted to the Patent and Trademark Office in conjunction
16 with a response filed September 2, 2003, and Exhibits thereto. (hereinafter Garner X)

17 Again, by Garner's own admission (Paper 15, page 2, lines 4-5), the Garner X
18 declaration did not form part of the 202(d)(1) submission. It is, likewise, new evidence
19 for purposes of the order to show cause and the showing.

20 4. A document entitled "Declaration Under 37 C.F.R. §41.202(b)" signed by the
21 inventor Harold R. Garner on December 8, 2005, and submitted to the Patent and

1 Trademark Office in conjunction with a document mailed January 26, 2006, and exhibits
2 thereto. (Garner II).

3 Garner II (and Garner I in October, 2005) were filed as part of the 202(d)(1)
4 showing and are properly evidence to be considered as to whether the 202(d)(1)
5 showing was sufficient.

6 5. A document entitled "Declaration" signed by John Fondon on October 20,
7 2005 and submitted to the Patent and Trademark Office in conjunction with a document
8 mailed January 26, 2006, and attached exhibit. (Fondon II).

9 Fondon II (and Fondon I in October, 2005) were filed as part of the 202(d)(1)
10 showing and are properly evidence to be considered as to whether the 202(d)(1)
11 showing was sufficient.

12 Rule 202(d)(2) issues a direct warning - "[n]ew evidence in support of priority will
13 not be admitted except on a showing of good cause."

14 The determination whether a party seeking to initiate an interference has shown
15 'good cause' for his failure to present the additional evidence at the time of his initial
16 submission is a matter within the discretion of the Board. *Huston v. Ladner*, 973 F.2d
17 1564, 1566, 23 USPQ2d 1910, 1912 (Fed. Cir. 1992) *citing Hahn v. Wong*, 892 F.2d
18 1028, 1034, 13 USPQ2d 1313, 1318 (Fed.Cir.1989) (discussing comparable prior Board
19 Rule 608). Good cause, in terms of a prior Rule 608 showing in an interference, has
20 been described as including, *inter alia*, a reason why the evidence was not available
21 and could not have been presented with the motion or any other valid reason.

22 Excluded from good cause is attorney conduct. See, e.g. *Huston* 973 F.2d at 1566, 23

1 USPQ2d at 1912-1913; Notice of Final Rule, Patent Interference Proceeding, 49
2 Fed.Reg. 48416, 48423 (Dec. 12, 1984). Bd. R. 202(d) has the same "good cause"
3 requirement.

4 The proof standards applicable to situations such as this one are discussed in
5 *Basmadjian v. Landry*, 54 USPQ2d 1617 (Bd. Pat. App. & Int. 1997).

6 Garner has not shown, nor attempted to show, good cause for the late
7 submission of the first three pieces of evidence as part of its showing. As a
8 consequence, we shall not consider the first three pieces of new evidence. Were we to
9 do otherwise in this instance, the PTO's clearly stated purpose for the good cause
10 requirement, streamlining and keeping the process efficient, would be stymied and
11 frustrated. What if we were to consider this evidence, and it were insufficient, and there
12 were yet additional pieces of new evidence that Garner could exhume from a related
13 application? Would we be required to give Garner a third chance? That is not the
14 purpose of Bd. R. 202. The applicant, in requesting an interference, is to present its
15 case fully, accompanied by its evidence, if it is titularly the junior party. The Board
16 cannot be expected to prospect in the records of the PTO for possible evidence
17 supporting the movants case in making its initial decision.

18 The time to show that one has sufficient evidence to prove one's case is at the
19 time of the 202(d)(1) submission. The place for one to do it is in the 202(d)(1)
20 submission. The evidence must be within the 202(d)(1) submission, relied upon and
21 discussed in the submission, or the applicant invites catastrophe.

1 iii) The Evidence Remaning in the Showing is Insufficient

2 What then, is left in the response?

3 The count is claim 39 of the instant application, which reads as follows:

4 An apparatus for catalyzing a reaction on a substrate, comprising:
5 a light source;
6 a computer controlled micromirror positioned to redirect light from the light source
7 toward the substrate; and
8 a reaction chamber, wherein the light redirected by the micromirror catalyzes a
9 chemical reaction proximate the substrate in the reaction.

10
11 The Applicant was aware that it needed to comply with the requirements of Bd.
12 R. 202 at the time of its initial attempt to provoke an interference (Page 2 of Arguments
13 submitted October 24, 2005). Indeed, the applicant observed that the requirement was
14 similar to prior Bd. R. 608 which required the applicant to make a prima facie case of
15 why it will prevail on priority (Page 3).

16 Garner's earliest apparent constructive reduction to practice date is June 4, 1998
17 (filing date of 60/087,948), which is after Quate's apparent constructive reduction to
18 practice date of May 29, 1998 (filing date of 60/087,333)(Paper 1, page 4). Garner was
19 therefore required to present evidence sufficient to prove a date of invention of the
20 subject matter of the proposed count before May 29, 1998. Garner's evidence must
21 have been sufficient to support a determination of priority in his favor. 37 CFR §
22 41.202(e).

23 "[P]riority of invention goes to the first party to reduce an invention to practice
24 unless the other party can show that it was the first to conceive of the invention and that
25 it exercised reasonable diligence in later reducing that invention to practice." *Medichem*

1 S.A. v. Rolabo S.L., 437 F.3d 1157, 1169, 77 USPQ2d 1865, 1873 (Fed. Cir. 2006)
2 quoting *Cooper v. Goldfarb*, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir.
3 1998).

4 Garner's attempt to meet Bd. R. 202(d) asserts only an earlier actual reduction to
5 practice. It is unnecessary, therefore, to consider conception and diligence.

6 "In order to establish an actual reduction to practice, the inventor must prove
7 that: (1) he constructed an embodiment or performed a process that met all the
8 limitations of the interference count; and (2) he determined that the invention would
9 work for its intended purpose." *Taskett v. Dentlinger*, 344 F.3d 1337, 1340, 68 USPQ2d
10 1472, 1474 (Fed.Cir. 2003) quoting *Cooper*, 154 F.3d at 1327, 47 USPQ2d at 1901.

11 In addition, an inventor's testimony as to the facts of the invention must be
12 corroborated by independent evidence. *Cooper*, 154 F.3d at 1330, 47 USPQ2d at 1903
13 ("In order to establish an actual reduction to practice, an inventor's testimony must be
14 corroborated by independent evidence."); *Hahn v. Wong*, 892 F.2d at 1032-33, 13
15 USPQ2d at 1317 (Fed. Cir. 1989); *Reese v. Hurst*, 661 F.2d 1222, 1225, 211 USPQ
16 936, 940 (CCPA 1981).

17 When considering the sufficiency of corroborating evidence a reasonableness
18 standard is used. *Scott v. Finney*, 34 F.3d 1058, 1061-62, 32 USPQ2d 1115, 1118 (Fed.
19 Cir. 1994); *Holmwood v. Sugavanam*, 948 F.2d 1236, 1238, 20 USPQ2d 1712, 1714
20 (Fed. Cir. 1991). Whether a putative inventor's testimony has been sufficiently
21 corroborated is determined by a "rule of reason" analysis, in which "an evaluation of all
22 pertinent evidence must be made so that a sound determination of the credibility of the

1 inventor's story may be reached." *Price v. Symsek*, 988 F.2d 1187, 1195, 26 USPQ2d
2 1031, 1037 (Fed. Cir. 1993). However, that "rule of reason" analysis does not alter the
3 requirement of independent corroboration of an inventor's testimony. *Brown v.*
4 *Barbacid*, 276 F.3d 1327, 1335, 61 USPQ2d 1236, 1240 (Fed. Cir. 2002). The inventive
5 facts must not rest alone on testimonial evidence from the inventor himself. *Brown*, 276
6 F.3d at 1335, 61 USPQ2d at 1240; *Cooper*, 154 F.3d at 1330, 47 USPQ2d at 1903.

7 The evidence is Garner I, Garner II, and Fondon I and II. Garner X (September
8 2, 2003), and the arguments pertaining to it (comprising the bulk of the Response,
9 Paper 15), have not been considered.

10 Garner's first request for an interference (October 25, 2005) argued that the
11 declarations showed that Garner had actually reduced the invention of the count to
12 practice before the effective filing date of the application that issued as the Quate patent
13 and was, therefore, prima facie entitled to priority.

14 Garner's counsel argued that an annotated photograph contained in the
15 declarations of Garner accomplished this:

16 The photograph contains all elements of the count. In the left hand portion
17 of the photograph as Exhibit B is a UV light source which meets the
18 requirement of Claim 39 that there be an ultraviolet light source in the
19 claimed apparatus. Further, in the photograph marked Exhibit B there is a
20 "DLP" connected to a DLP driver board and a DLP power supply. DLP
21 refers to a digital light programming device which is the same thing as the
22 "computer controlled micromirror position to redirect light from the light
23 source toward the substrate" as presently recited in Claim 39 of this patent
24 application. Also shown in the photograph in Exhibit B is a "reaction
25 chamber mount" containing the reaction chamber, which is the same thing
26 as the element recited in Claim 39 of "a reaction chamber, wherein light
27 redirected by the micromirror catalyzes a chemical reaction proximate the
28 substrate in the reaction." The substrate reaction is contained within the

1 reaction chamber in the reaction chamber mount and the successful
2 catalysis of the reaction is demonstrated by the chemistry of the
3 successful run which is contained in Exhibit C3 attached to the Declaration
4 by inventor Garner. (Paper submitted October 25, 2005, unpaginated,
5 under "Evidence of Priority")
6

7 It is well established that the remarks of counsel are no substitute for evidence.

8 See *Estee Lauder Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595, 44 USPQ2d 1610, 1615

9 (Fed. Cir. 1997) (Argument of counsel cannot take the place of evidence lacking in the
10 record).

11 Garner's complete testimony on the reduction to practice of the subject matter of
12 the proposed count is reproduced below:

13 4. To establish the date of completion of the invention of this
14 application, the following copies of a presentation related to a grant
15 application is attached hereto as Exhibit A and submitted as evidence.
16 The photograph in Exhibit A was taken in August 1997 and demonstrates
17 that the device as claimed had been built and was operating prior to the
18 filing date of the reference cited as prior art in the parent application of this
19 filing. Exhibit A, attached hereto demonstrates that the device as claimed
20 had been not only conceived but reduced to practice before the filing date
21 of the art cited in the parent application. Furthermore, this affidavit in
22 conjunction with the affidavit under 37 C.F.R. §1.131 filed in the parent
23 application demonstrated that the device was used to form a mask pattern
24 formed and printed using the present device, and was therefore reduced
25 to practice in the United States prior to the filing date of the art used for
26 the rejection.
27

28 5. From the lab notebook pages attached hereto as Exhibit A, it can
29 be seen that the invention in this application was used to produce a mask
30 pattern on a substrate on the date even therewith, which is on or before
31 February 23, 1998, which is a date earlier than the effective date of the
32 reference cited in the parent application. (Garner I, pp. 1-2.)
33

34 Garner I also refers to and relies upon a declaration filed "in the parent case,"

35 Application 09/326,526. That declaration is not in evidence. Even were we to assume it

1 were appropriate to incorporate it by reference, it merely states that the laboratory
2 notebook pages attached to the declaration show that "invention in the application" was
3 used to produce a mask pattern on a substrate on or before February 23, 1998.

4 Application 09/326,526, Declaration filed March 1, 2001, pp. 1-2. (hereinafter
5 Garner 0).

6 Garner's complete testimony relating to the date of the invention from Garner 0 is
7 as follows:

8 4. To establish the date of completion of the invention of this
9 application, the following copies of lab notebook pages are attached
10 hereto as Exhibit A and submitted as evidence.

11
12 5. From the lab notebook pages attached hereto as Exhibit A, it can
13 be seen that the invention in this application was used to produce a mask
14 pattern on a substrate on the date even therewith, which is on or before
15 February 23, 1998, which is a date earlier than the effective date of the
16 reference. (Application 09/326,526, Declaration filed March 1, 2001, pp.
17 1-2.)
18

19 Exhibit A is a photograph of a machine with labels added. We are not informed
20 who added the labels, or when the labels were added. Did counsel label the machine,
21 or is it an original from the grant presentation? There is no testimony as to the meaning
22 of or accuracy of the labels.

23 In sum, the evidence from each of Garner 0, I, and II shows:

24 (1) a machine was built by August 1997.

25 (2) a mask pattern may have been formed on a substrate.

26 In evaluating a priority showing under § 41.202(d) we look to the count proposed
27 by the applicant pursuant to § 41.202(a)(2).

1 The count is directed to an apparatus for catalyzing a reaction on a substrate,
2 comprising:

3
4 (1) a light source;

5
6 (2) a computer controlled micromirror positioned to redirect light from the light
7 source toward the substrate; and

8
9 (3) a reaction chamber, wherein the light redirected by the micromirror catalyzes
10 a chemical reaction proximate the substrate in the reaction.

11
12 To show priority, Garner had to prove, with corroborated evidence, that each of
13 the above elements of the apparatus were present, worked as intended, and catalyzed
14 a chemical reaction proximate the substrate in the reaction.

15 Garner 0, Garner I, Garner II, Fondon I, and Fondon II, with the attachments
16 submitted with the declarations, do not show that the specific elements of the proposed
17 count were present and worked for their intended purpose.

18 Garner testified that the device shown in the copy of the photograph in "Exhibit A"
19 was built and operating in August 1997. Garner 0, Garner I, pp. 1-2. Garner does not
20 testify in either declaration as to the specific operating parts of the device. The
21 photograph of the device did not show how each part of the device worked as described
22 in the count. Consequently, Garner did not provide sufficient evidence to carry its
23 burden of proof that the elements of the count were present in the machine depicted in
24 the photographs.

25 Even were we to accept somehow the labels on the photograph as "evidentiary"
26 in nature (we do not); they would still fall short of showing each part of the device. For
27 example, the presence of a "reaction chamber mount" does not establish that there was

1 a reaction chamber present “wherein the light redirected by the micromirror catalyzes a
2 chemical reaction proximate the substrate in the reaction.” Additionally, the presence
3 of a “DOC Process Control Computer,” a “DLP,” “DLP Driver Boards,” and a “fluid
4 injection stage” does not establish that there was “a computer controlled micromirror
5 positioned to redirect light from the light source toward the substrate,” counsel’s
6 assertions notwithstanding.

7 Garner also testified that the lab notebook pages show that the invention in the
8 application was used to produce a mask pattern on a substrate before February 23,
9 1998. Garner I, pp. 1-2. However, Garner did not explain the content of the notebook
10 pages and how those pages demonstrate that the light redirected by the micromirror
11 catalyzes a chemical reaction proximate the substrate in the reaction.” Nor did Garner
12 explain how the content of the notebook pages relate to the device purportedly shown in
13 the photograph.

14 From a review of the submitted notebook pages, the computer controlled
15 micromirror positioned to redirect light from the light source toward the substrate; and
16 the reaction chamber, wherein the light redirected by the micromirror catalyzes a
17 chemical reaction proximate the substrate in the reaction are not apparent.

18 We observe that one of the notebook pages includes the word “mask” and an
19 arrow pointing to a region on the page in Garner I or Garner 0. Only a vague speckled
20 rectangle is visible. In any event, Garner has not explained what is shown by the
21 “mask” and how it demonstrates that a reaction was catalyzed proximate to the surface
22 of a substrate in the reaction chamber.

1 Thus, we conclude that Garner's declarations I and II, and the attached copies of
2 the photographs and notebook pages do not prove that the process of the proposed
3 count was actually reduced to practice.

4 Fondon I was submitted for the purpose of corroborating Garner's testimony.
5 (Application 09/998,341, Remarks dated October 24, 2005) Fondon testifies that he
6 saw a photograph of a prototype of a device in Dr. Garner's laboratory from November
7 of 1997. The photograph appears to be identical to one of the photographs attached to
8 Garner I and Garner II.

9
10 The Fondon declarations similarly fail to establish that the apparatus of the
11 proposed count was actually reduced to practice. Fondon's declaration refers to a copy
12 of a photograph that is said to show a prototype of a digital optical chemistry micromirror
13 imager. Fondon I and II, p. 1. The copy of the photograph appears to be the same as
14 one of the copies attached to Garner's declarations. Fondon does not testify how the
15 photograph demonstrates an actual reduction to practice of each element of the
16 apparatus of Garner's proposed count. Fondon, while testifying that he saw the device
17 shown in the photograph in Garner's laboratory in November 1997, does not testify that
18 the device contained the elements of the count or that they worked for their intended
19 purpose.

20 At best, the Fondon declarations corroborate the existence of a device
21 purportedly shown in the photographs. However, they do not prove or corroborate that
22 the device of the proposed count was operated and worked for its intended purpose.

1 The Fondon declarations, like Garner's, fails to establish that the apparatus of the count
2 was actually reduced to practice.

3 Garner's attachments to the declarations have been carefully reviewed.
4 However, absent testimony explaining how the copies of the photographs and notebook
5 pages show that all the elements of the proposed count were actually present and
6 achieved the desired result, Garner's evidence submitted October 24, 2005 and
7 January 26, 2006 fail to establish an actual reduction to practice and fail to prove that he
8 has a basis to prevail on priority. 37 CFR § 41.202(e).

9 D. Conclusion

10 As Garner has failed to show cause why judgment should not be entered against
11 it, judgment is entered against Garner in a separate paper filed today.

/Richard E. Schafer/ ADMINISTRATIVE PATENT JUDGE))))	
/Jameson Lee/ ADMINISTRATIVE PATENT JUDGE))))	BOARD OF PATENT APPEALS AND INTERFERENCES
/James T. Moore/ ADMINISTRATIVE PATENT JUDGE))))	

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